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In re Application of
Braun et al
Serial No.: 09/687,483
Filed: October 13, 2000
Attorney Docket No.: 24736-2033

Decision on Petition

This is in response to applicant's "Petition Under 37 CFR 1.144 Petition From Requirement for Restriction" filed July 10, 2002. The delay is regretted.

On September 21, 2001, a Restriction Requirement was mailed. On July 10, 2002 the instant petition was filed. Applicants request reconsideration and removal of the restriction between Groups II and V and between Groups II and XVI, and petition for combining the claims of Groups II, V, and XVI for examination in this application.

The restriction requirement, mailed September 21, 2001, sets forth sixteen(16) Groups. Applicants elected, with traverse, Group II in an election mailed March 18, 2002. The examiner deemed applicants' arguments unpersuasive and made the restriction final in the Office Action mailed May 13, 2001. Applicants submit that Group II is related to each of Groups V and XVI as subcombination/combination for which a showing of two-way distinctness is required. Applicants urge that Group II is directed to a database containing datapoints representative of plurality of healthy organisms, and Group V is directed to a system for high throughput processing of biological samples that includes an automated process line, a data analysis system, a control system, and a database of claim 8 (Group II). Hence, Groups II is related to Group V as a combination/subcombination, where the system is the combination and the database is the subcombination. In addition, applicants submit that restriction between Groups II and XVI is improper because the Groups are not patentably distinct, for essentially the same reasons as discussed for groups II and V. Applicants state that Group II, the subcombination, includes claims directed to database containing datapoints representative of plurality of healthy organisms. Group XVI, the combination, is directed to a system for high throughput processing of biological samples that includes a database of Group II. Applicants assert that the examiner fail to show that the combination does not require the subcombination to be patentable. Furthermore, applicants petition for removal of requirement for election of species for the elected

claims. Applicants urge that in the instant application, the subject matter for which a search would be conducted is a database as claimed, not the datapoints that constitute the database. Applicants assert that the requirement for election of a single parameter of instant claim 9 as a "species" is inconsistent with the subject matter claimed. A database composes of a single parameter or type of datapoint could not be sorted by parameter if only one parameter is contained therein. Applicants further assert that such requirement could violate applicants' right to have all species that form a single general inventive concept included in a single application.

Applicants' arguments and the restriction have been carefully reviewed. The examiner's reason for Groups II-XIV was that these groups differ in the tactics employed in the identification of the defined target and the definition of that target. These groups have the varying target of polymorphisms; an extended primer, genotype data, and the methods vary from use of a mass spectrometer, high throughput biological processing, and the use of a data analysis system. The targets or products in the instant case can be used for the production of cDNA in the case of the primers and the genotype data can be used in identifying alternative diseases. It is noted that the examiner failed to establish that the inventions as grouped are independent or distinct, and there is serious burden to examine all inventions. Furthermore, Groups II and V and Groups II and XVI are related as combination and subcombination as urged. As indicated in MPEP 806.05(c), in order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reason for insisting on restriction are necessary, i.e. separate classification, status, or field of search. The inventions are distinct if it can be shown that a combination as claimed:

- (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and
- (B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

In the instant case, Claim 32 (Group V) requires the particulars of the subcombination as claimed in claim 8 (Group II). The same relationship exists between Claim 100 (Group XVI) and claim 8 (Group II). Thus even if the database of claim 8 (Group II) can be shown to have utility either by itself or in other and different relations, the inventions are not distinct and restriction between them is improper.

The restriction between Groups II, V, and XVI is improper. Groups II, V and XVI will be combined for examination. The election of species is also withdrawn.

Petition Granted.

Should there be any questions with respect to this decision, please contact Cecilia Tsang, by mail address to: Director, Technology Center 1600, Alexandria, VA 22313-1450, or by telephone at (703) 308-0254 or by facsimile transmission at (703) 305-7230.

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